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09/727,874	12/01/2000	David C. Turner	VTN-518	4049

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EXAMINER

SIMONE, CATHERINE A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/18/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/727,874

Applicant(s)

TURNER ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Withdrawn Rejections*

1. The 35 U.S.C. 112 rejections of claims 6-15 of record in Paper #5, Page 2, Paragraph 3 have been withdrawn due to the Applicant's amendment in Paper #8.
2. The 35 U.S.C. 103 rejection of claims 6-11 over Nicolson et al. recorded in Paper #5, Page 3, Paragraph #5 has been withdrawn due to the Applicant's argument in Paper #8.
3. The 35 U.S.C. 103 rejection of claims 12 and 13 over Nicolson et al. in view of Maiden et al. and in further view of Bonafini, Jr. recorded in Paper #5, Pages 4-5, Paragraph #6 has been withdrawn due to the Applicant's argument in Paper #8.
4. The 35 U.S.C. 103 rejection of claims 14 and 15 over Nicolson et al. in view of Kunzler et al. recorded in Paper #5, Pages 5-6, Paragraph #7 has been withdrawn due to the Applicant's argument in Paper #8.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (6,203, 156).

Wu et al. discloses a silicone hydrogel contact lens (see col. 3, lines 50-52) comprising at least one surface with periodic structures on the surface (Fig. 2, #11) and an amplitude of less

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than about 4 nm RMS (see col. 2, lines 61-64). However, Wu et al. fails to disclose a periodicity of less than about 3  $\mu\text{m}$ . The periodicity would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the periodic structures on the surface in Wu et al. with a periodicity of less than about 3  $\mu\text{m}$ , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absence of showing unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

7. **Claims 7-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (6,203,156) in view of Vanderlann et al. (EP 0 940 693).

Wu et al. discloses a silicone hydrogel contact lens (see col. 3, lines 50-52) comprising at least one surface with periodic structures on the surface (Fig. 2, #11) and an amplitude of less than about 4 nm RMS (see col. 2, lines 61-64). However, Wu et al. fails to disclose a hydrophilic coating selected from the group recited in claim 8. Vanderlaan teaches that it is old and well-known in the analogous art to have a hydrophilic coating (see page 5, lines 48-51) for the purpose of producing a silicone hydrogel lens.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the contact lens in Wu et al. with a hydrophilic coating as suggested by Vanderlaan et al. in order to produce a silicone hydrogel lens.

8. **Claims 12 and 13** are rejected under 35 U.S.C. 103(a) as being obvious over Wu et al. (6,203,156) in view of Maiden et al. (6,367,929).

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The applied reference (Maiden et al.) has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Wu et al. discloses a silicone hydrogel contact lens (see col. 3, lines 50-52) comprising at least one surface with periodic structures on the surface (Fig. 2, #11) and an amplitude of less than about 4 nm RMS (see col. 2, lines 61-64). However, Wu et al. fails to disclose the silicone hydrogel comprising a Group Transfer Polymerization product of a reaction mixture comprising 2-hydroxyethyl methacrylate, methyl methacrylate, methacryloxypropyltris(trimethylsiloxy)silane, and monomethacryloxypropyl terminated monobutyl terminated polydimethylsiloxane and a polymerizable mixture comprising a Si 7-9

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monomethacryloxy terminated polydimethyl siloxane; a methacryloxypropyl tris(trimethyl siloxy) silane; N,N-dimethyl acrylamide; 2-hydroxy ethyl methacrylate; and tetraethyleneglycol dimethacrylate. Maiden et al. teaches it is old and well-known in the analogous art to have a silicone hydrogel comprising a Group Transfer Polymerization product of a reaction mixture comprising 2-hydroxyethyl methacrylate, methyl methacrylate, methacryloxypropyl-tris(trimethylsiloxy)silane, and monomethacryloxypropyl terminated mono-butyl terminated polydimethylsiloxane and a polymerizable mixture comprising a Si 7-9 monomethacryloxy terminated polydimethyl siloxane; a methacryloxypropyl tris(trimethyl siloxy) silane; N,N-dimethyl acrylamide; 2-hydroxy ethyl methacrylate; and tetraethyleneglycol dimethacrylate for the purpose of producing a silicone hydrogel lens.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the lens in Wu et al. comprise a Group Transfer Polymerization product of a reaction mixture comprising 2-hydroxyethyl methacrylate, methyl methacrylate, methacryloxypropyltris(trimethylsiloxy)silane, and monomethacryloxypropyl terminated mono-butyl terminated polydimethylsiloxane and a polymerizable mixture comprising a Si 7-9 monomethacryloxy terminated polydimethyl siloxane; a methacryloxypropyl tris(trimethyl siloxy) silane; N,N-dimethyl acrylamide; 2-hydroxy ethyl methacrylate; and tetraethyleneglycol dimethacrylate as suggested by Maiden et al. in order to produce a silicone hydrogel lens.

9. **Claims 14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (6,203,156) in view of Kunzler et al. (5,539,016).

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Wu et al. discloses a silicone hydrogel contact lens (see col. 3, lines 50-52) comprising at least one surface with periodic structures on the surface (Fig. 2, #11) and an amplitude of less than about 4 nm RMS (see col. 2, lines 61-64). However, Wu et al. fails to disclose the silicone hydrogel comprising a fluorosiloxane hydrogel. Kunzler et al. teaches that it is old and well-known in the analogous art to have a silicone hydrogel comprising a fluorosiloxane hydrogel (see col. 2, lines 5-7) for the purpose of producing a silicone hydrogel lens.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the lens in Wu et al. with a fluorosiloxane hydrogel as suggested by Kunzler et al. in order to produce a silicone hydrogel lens.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 6-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone  
Examiner  
Art Unit 1772

August 6, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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8/7/03